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Paper No. 14
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TRM Corporation

Serial No. 75/934,901

James H. Walters of Dellett and Walters for TRM Corporation.

Jill C. Alt, Trademark Examining Attorney, Law Office 114 (Margaret Le, Managing Attorney).

Before Simms, Bucher and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

TRM Corporation seeks to register IATMNETWORK as a mark for "automated teller machine services," in International Class 36.¹ Registration has been refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). The examining attorney's position is that,

¹ Serial No. 75/934,901, filed March 3, 2000, based upon an allegation of applicant's bona fide intention to use the term in commerce.

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when used in connection with applicant's services, IATMNETWORK will be merely descriptive of them.

When the examining attorney made the refusal final, applicant appealed and filed a request for reconsideration, which the examining attorney denied. The appeal then resumed and has been fully briefed. Oral argument was not requested.

The Record

The Office bears the burden of setting forth a prima facie case in support of a descriptiveness refusal. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (When the examining attorney sets forth a prima facie case, the applicant cannot simply criticize the absence of additional evidence supporting the refusal, but must come forward with evidence supporting its argument for registration.). To meet the Office's burden, the examining attorney has made of record evidence from an on-line acronym finder which shows that "I" can mean, among other things, "Internet" and that "ATM" can mean, among other things, "Automated Teller Machine"; an excerpt from an on-line publication titled the Tech Encyclopedia (www.techweb.com/encyclopedia) showing that "I-commerce" is defined as "Internet commerce"; definitions of "Internet"

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from both an on-line dictionary and a printed computer dictionary; definitions of "ATM" and of "Network" from an on-line dictionary; a press release from applicant, appearing on the KIOSKS.ORG Web site and on certain wire services, the former evidenced by a copy of the Web pages and the latter evidenced by copies of wire service articles or excerpts retrieved from NEXIS; excerpts of articles retrieved from NEXIS by virtue of searches for references to I ATM or IATM, or references to Internet and ATM, or references to ATM and bank, banks, banking, etc.; excerpts of articles retrieved from NEXIS which explain that "I" or "i" as used in certain composite terms or domain names is intended to mean "Internet."

Applicant, in response to an examining attorney requirement made pursuant to Trademark Rule 2.61, 37 C.F.R. §2.61, submitted reprints of Web pages from its iATMglobal subsidiary. Also, with its request for reconsideration applicant included copies of records retrieved from the Office's Trademark Electronic Search System (TESS), showing registration of certain marks composed of "I" and another term; a copy of a Web page from the International Association of Transport and Communications Museums, www.iatm.org; and a copy of records retrieved from the United Kingdom trademark registry showing that applicant

has obtained registration of IATMNETWORK in the United Kingdom.

Arguments

The examining attorney has argued that the letter "I" is equivalent to "Internet," and would be perceived, when used as part of IATMNETWORK in connection with applicant's services, as indicating that applicant's services are "Internet-enabled"; that "ATM" means "automated teller machines" and "[w]hatever else applicant's services may be, they are certainly centered around 'ATMs'"; and that "network," as used in IATMNETWORK, will be readily perceived as having the connotation of an interconnected set of computers and, therefore, as referring to "a network of Internet-enabled ATM's [sic], not just one."

In essence, the examining attorney is arguing that consumers of applicant's goods or services would readily perceive IATMNETWORK as a shorthand version of the phrase Internet ATM network, and that applicant has created or administers an Internet-enabled ATM network, so that the designation IATMNETWORK is not suggestive but, rather, immediately conveys the nature of applicant's services.

Applicant argues that IATMNETWORK is at most suggestive and does not inherently denote automated teller

machines. In this regard, applicant notes that IATM can mean various things and refers to the NEXIS reference and Web page that show IATM is an acronym for the International Association of Transport and Communications Museums and to the NEXIS reference that shows IATM is a stock exchange symbol for Interactive Terminals Inc. Applicant asserts that it is only because of its use of IATMNETWORK that the designation has any association with ATM services.

Applicant also argues that the examining attorney is wrong in arguing that designations coupling "I" or "i" with another term are readily perceived as describing Internet based services. To support this contention, applicant notes that the Office has registered other "I"-formative terms. Further, applicant attempts to distinguish this Board's decision of In re Zanova, Inc., 59 USPQ2d 1300 (TTAB 2001), which held that "Internet tools" is a term commonly used for various software programs and that prospective consumers or users of the services involved in that case would readily perceive the "I" in "ITOOL" as referring to the Internet. Specifically, applicant argues that the Zanova case is distinguishable because its services are not computer services, but ATM services, so that there would be no immediate association with the Internet.

Additional arguments by applicant rely on registration of IATMNETWORK in the United Kingdom; the assertion that the record does not show any competitors using IATMNETWORK and, in fact, almost all of the NEXIS references showing use of IATM are references to applicant; and that the examining attorney has unfairly denied applicant registration by dissecting IATMNETWORK into the components I, ATM, and NETWORK and by not considering the registrability of the composite.

Decision

The question whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser or user of the goods or services. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979) and In re Recovery, 196 USPQ 830 (TTAB 1977).

A proposed mark is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof, or

if it directly conveys information regarding the nature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978); see also In re Gyulay, *supra*. It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). Thus, it is not necessary, in this instance, that a prospective user of ATMs that may be provided or administered by applicant be immediately apprised of the full panoply of features available through the machines for the term IATMNETWORK to be found merely descriptive. Moreover, in this case we consider the significance of IATMNETWORK not just to users of ATMs but to businesses whose ATMs may be enhanced or administered through services provided by applicant. This is because we consider the recitation of "automated teller machine services" to be broad enough to encompass not only services that, for example, a bank account holder may obtain from an ATM, such as withdrawal of money or transferring funds between accounts, but also services related to the administration or enhancement of ATMs, such as would be provided by an

entity that manages or maintains a network of ATMs for a bank or financial services company.

From the record it is clear that ATM, while it may be an acronym for many things, is commonly used shorthand for "automated teller machine," and it is equally clear that ATMs are widely available. Their proliferation stems from their convenience for users and the operational efficiencies they provide to banks and other financial services companies. It is also clear that there are different networks of ATMs and that users of banking services obtained through ATMs are no doubt aware of this, if not for any other reason then at least because of the financial repercussions attributable to obtaining services inside or outside a particular network. Applicant itself discusses ATM networks on its Web pages:

...[Applicant's RAAP software] checks that all connecting ATMs are genuine and registered ATMs - with all the necessary security checks you would expect of an ATM network. ...
...Similarly [sic] as each new internet partner joins they too have access to an ever increasing ATM network.

Thus, if the designation applicant sought to register was ATMNETWORK, we would have no doubt that this would have immediate descriptive significance for both end users of ATMs and for banks and financial services companies that

administer or participate in an ATM network. The combination ATM and NETWORK into one term would not lead either class of consumers to fail to recognize and grasp the significance of both ATM and NETWORK and would not result in any incongruity, ambiguity or any other distinctive effect. They might not immediately know the full range of ATM related services applicant provides, but that is not a prerequisite to finding a term descriptive under the Lanham Act. Of course, ATMNETWORK is not the designation applicant seeks to register. Applicant has not combined just ATM and NETWORK, but has combined I and ATM and NETWORK.

We have no doubt that the combination IATMNETWORK would also have immediate descriptive significance for businesses that would obtain automated teller machine related services from applicant to enhance ATMs in their respective networks. Despite applicant's arguments to the contrary, such consumers would immediately discern that I is a reference to the Internet. The record is clear that there are expanding efforts to enhance the functionality of ATMs by connecting them to the Internet. See, for example:

Using technology for delivery means souping up even Old Economy equipment such as automated teller machines. Wells [Fargo] is in the process of hooking to the Internet at least 800 of its ATMs in California and Arizona and plans to do

the same throughout its territory. Consultants may debate the merits of Web-enabling ATMs, but several large banks, such as Bank of America, have announced plans to do it.

-*The Charlotte Observer*, June 19, 2000.

The record is also clear that applicant offers Web-enabling services to owners of ATM networks. As noted earlier, we consider such services to be encompassed by the recitation "automated teller machine services." There is nothing incongruous, ambiguous or otherwise distinctive resulting from the combination of I, ATM and NETWORK that would require business consumers to pause or cogitate on the meaning of the combination, when considered in connection with applicant's services.

End users of ATMs also would find IATMNETWORK to have immediate descriptive significance, i.e., to indicate that applicant's services involve providing end users with Web-enabled ATMs. In this regard, we note that ATMs are commonly available and are not doubt used by some individuals who are less Internet-savvy than others. Nonetheless we find that the average end user of an ATM would likely have sufficient familiarity with the Internet to conclude, when considering IATMNETWORK in conjunction with automated teller machines that such user would immediately know that an IATMNETWORK ATM would be one that is connected to the Internet. IATMNETWORK is not rendered

non-descriptive and therefore registrable merely because there may be some users of ATMs who do not use the Internet and might not, therefore, draw the same conclusions that an average user would. Likewise, the term is not rendered non-descriptive and registrable merely because the average end user of an ATM might not be immediately aware of how an ATM is connected to the Internet or of what information and services obtainable through the Internet would also be obtainable through an IATMNETWORK ATM. It is sufficient that they would immediately conclude that the ATM's Internet connection is a significant feature of the machine and therefore of the services obtainable from it.

We are not persuaded of the registrability of IATMNETWORK by applicant's argument that it has been able to register the term abroad; we are bound to determine registrability under the applicable law of the United States. Nor are we persuaded that the term is registrable merely because some "I"-formative marks have been registered in the United States. It is clear that each case must be decided on its own record and that, while Office consistency is desirable, the correct result in an individual case is paramount. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Finally, we are not persuaded that IATMNETWORK is registrable merely

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because applicant may be the only user of the complete combination IATMNETWORK and one of a few users of IATM. *Zanova*, supra at 1305.

In closing, we note that applicant has argued that it has unfairly been denied registration because the examining attorney has dissected the elements of IATMNETWORK, found each descriptive, and then refused registration of the composite. Applicant has not, however, articulated any theory why the combination of these elements results in a registrable mark. As noted, we see no resulting incongruity, ambiguity or other form of distinctiveness that results from the combination. There is nothing impermissible in considering the connotative significance of elements of a term, so long as the ultimate determination of registrability is based on consideration of the mark as a whole. *Id.* at 1304-05. Having so considered IATMNETWORK, we find the term merely descriptive.

Decision: The refusal of registration under Section 2(e)(1) of the Lanham Act is affirmed.